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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,054	05/26/2006	Rainer Breitenbach	INA-40	1220
20311 7590 07/21/2009 LUCAS & MERCANTI, LLP 475 PARK AVENUE SOUTH 15TH FLOOR NEW YORK, NY 10016				
EXAMINER GARCIA, ERNESTO				
ART UNIT 3679		PAPER NUMBER		
NOTIFICATION DATE 07/21/2009		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

info@lmiplaw.com

**Advisory Action  
Before the Filing of an Appeal Brief**

<b>Application No.</b> 10/596,054	<b>Applicant(s)</b> BREITENBACH ET AL.
<b>Examiner</b> ERNESTO GARCIA	<b>Art Unit</b> 3679

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 07 July 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 15-18.  
Claim(s) withdrawn from consideration: 1-14.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☒ Other: See Continuation Sheet.

/Daniel P. Stodola/  
Supervisory Patent Examiner, Art Unit 3679

Continuation of 13. Other: Re: item 7b: Applicants argue that the undercut and shank have internal threading. In response, this argument is not commensurate with the scope of the claimed invention as there is no indication that the undercut has an internal threading and neither is the shank set forth in the claim with an "internal threading". Applicants further argue that the "nut is housed within a device". In response, applicants should note that the claimed invention has not mention of "the nut being housed within a device". Applicants further argue that "Nelsen does not anticipate the present invention because the flange of Nelsen is not fixed directly to the bolt". In response, this argument is not commensurate with the scope of the claimed invention as the claim does not mention that the "flange is fixed directly to the bolt". It should be noted that the claims control as to what is being patented and not what the specification states is the invention.

Applicants further argue that the reference character A3 is not a shank since a shank is a narrower shaft-like part. In response, what constitutes a narrower shaft-like part? Further, relative to what is the shank being compared to render being narrow? Note that the claim does not set forth any mention of being narrow or that the shank is a shaft. It should be reminded that shanks come in different shapes and sizes and the one identified as A3 qualifies as a shank in the broadest reasonable interpretation. Applicants further argue that the bolt of Nelsen does not directly connect the flange and the nut. In response, the claimed invention does not state anything about being "directly connected".

Applicants further argue that the present invention discloses "a radial wall which has a smaller diameter than the nut and a shank which has yet a smaller diameter than the radial wall". In response, this argument is also not commensurate with the scope of the claimed invention. Nowhere is there any mention that "the radial wall has a smaller diameter than the nut and the shank having a smaller diameter than the radial wall". Applicants then remark that the configuration of the present invention and Nelsen are not the same. In response, the configuration might not be the same as disclosed by the present invention. However, the claimed invention is still anticipated by Nelsen and there is nothing structurally different in the claims to define over Nelsen. Applicants further argue that the shank of Nelsen is not fixed internal to the flange and that the nut of Nelsen is not intended to be used in the same manner as the nut of the present invention. In response, it should be noted that the claimed invention does not state "the shank being fixed internal to the flange" and thus the argument is not again commensurate with the scope of the claimed invention. With respect to how the nut is adapted, it should be first noted that patentability is based on the structural differences and not how the nut is adapted to be used. If applicants are concerned on how the nut is to be used, then applicant should rather considered applying for a method of utilizing a nut in a divisional application. Applicants further argue that the nut in Nelsen does not fix a device to the flange. In response, it should be reminded that the claimed invention does not state "the nut fixing a device to the flange" and thus the argument is not commensurate with the scope of the invention.

With respect to Hetmann et al., applicants argue that the nut of Hetmann et al. is not formed as part of a component. In response, it should be noted that the rejected claims do not state "the nut being formed as part of a component". In any event, the nut 57 in Hetmann et al. is part of multiple components in the broadest reasonable interpretation. Applicants further argue that the nut of the present invention is part of the device and is not removable like the nut of Hetmann. In response, it should be first noted that the claimed invention does not state "a device" and thus the argument is not commensurate with the scope of the claimed invention. With respect to the nut not being removable, the claim does not state that the nut is welded to render being "not removable". Further, the claim does not state any structure that prevents the nut from not being removed. Applicants further argue that the screw 69 of Hetmann is only threaded at its end closest to the wheel spindle 54 collar 55. In response, the examiner is not relying on screw 69 as the bolt but rather on a portion of the part 54, which can be considered a hollow bolt integral with the spindle 54. It seems that the applicants have misinterpreted the screw 69 as the bolt when the examiner is relying on a fragment of the part 54 as the bolt. Applicants then remark that the head of the screw 69 secures the flange in place. In response, it should be noted that the head alone does not secure the flange in place. The remaining components, i.e., the thread, the shank, the threaded portion of the spindle 54, the nut, the bearings 53, etc., which cooperate directly or indirectly with the head of the screw 69 are required and secure the flange in place in the broadest reasonable interpretation. Applicants further argue that the nut is not directly connected to the bolt. In response, it should be noted that the claimed invention has no mention of "the nut being directly connected to the bolt", and the portion at the end of the spindle 54, which has been considered the bolt, is directly connected to the nut. Applicants further argue that the bolt head of Hetmann et al. is not located in a recess of the flange. Applicants further argue that no bolt head is associated with the screw of the present invention. In response, it should be noted that the claimed invention has been set forth open-ended and thus the fact that other features are present in Hetmann et al. is irrelevant until claimed closed-ended. Applicants further argue that the groove in Hetmann et al. is not an undercut as disclosed in the present invention. In response, it should be noted that undercuts come in different shapes and sizes and the groove is Hetmann et al. qualifies as an undercut. It should also be noted that the configuration of the undercut has not been set forth in the rejected claims and thus any cut in any nut qualifies as an undercut. Applicants further argue that the groove is a section of the nut that has a diameter which is larger than the nut. In response, it is unclear how the applicants arrived to such conclusion when the groove is part of the nut and thus the diameter of the groove qualifies as a diameter of the nut. Accordingly, Hetmann et al. qualifies as a valid reference since the reference anticipates the claimed invention and specially since Hetmann et al. disclose an undercut with a radial wall facing a flange and a shank extending (viz. extending from) the nut axially. Applicants further argue that the present invention does not have a section of the nut which has a diameter greater than the main body of the nut. Again, there's nothing in the rejected claims that negate the nut from having a portion with a diameter greater than the main body.

The drawings filed on July 7, 2009 are acceptable.